

## **2.0 RESPONSE**

### **2.1 CHANGE OF APPLICANTS' REPRESENTATIVE**

Applicants note for the record that representation of this matter has recently been transferred to the undersigned representative. Authorization for the transfer of this matter to the undersigned's firm was granted and the representative submitted a revocation of power of attorney, a new power of attorney, and a change of customer number/correspondence address to formalize this change of representation On August 8, 2005.

**The new attorney docket number for this case is 36677.29,** and Applicants appreciate the Examiner's so noting of this in all subsequent communication with the undersigned representative.

Likewise, should the Office or the Examiner-in-Charge of this application have any questions, the Applicants' new undersigned representative may be contacted at the following address:

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### **2.2 STATUS OF THE CLAIMS**

***Claims 8-19, 32-35, 39, 40 and 44-52 were pending at the time of the Action.***

***Claims 8-19, 32-35, 39-40, and 44-52 have been amended herein.***

***Claims 8-19, 32-35, 39-40, and 44-52 remain pending in the application.*** In accordance with 37 C. F. R. § 1.121, the pending claims are listed in the amendment section.

### **2.3 SUPPORT FOR THE CLAIMS**

Support for the revised claims exists throughout the specification and claims of the original and parent applications. In light of the claims canceled to date, no fees should be required for the new claims. Applicants certify that no new matter was added as a result of the present amendment.

Claims were amended from the European style preamble "A method according to claim...." to recite the U.S.-style dependent claim preamble language, "The method of claim..." Support for the amendment to claim 19 is found at least on pages 39-42 and Scheme 7 of the Specification.

### **2.4 RESPONSE TO OFFICIAL ACTION**

Applicants incorporate herein by reference all arguments and reasoning presented in the earlier responses on record in the pending matter. It is respectfully submitted that the pending claims are fully enabled by the specification, that all pending claims are definite, and that all claims are free of the cited prior art. Applicants believe that the claims are acceptable under all sections of the Statutes and are now in conditions for ready allowance, and that all of the concerns of the Examiner have been resolved. Applicants respectfully request, therefore, the withdrawal of all rejections and that a Notice of Allowance be issued in the case with all due speed. However, Applicants note for the record their explicit right to re-file claims to one or more aspects of the invention as originally claimed in one or more continuing application(s) retaining the priority claim of the present case.

## **2.5 THE OBJECTION TO CLAIM 19 IS OVERCOME**

***Claim 19 was objected to, allegedly for containing species of non-elected compounds.***

***(Action at page 3)***

Without acquiescing to the propriety of the initial species "selection" imposed in the original restriction requirement, and solely in order to progress certain claims of commercial relevance to speedy allowance, Applicants hereby amend claim 19 to reflect a six-member aromatic ring structure. Applicants expressly reserve the right to re-file claims to the non-elected inventions in a suitable continuing or divisional application.

Applicants respectfully request that the objection now be withdrawn.

## **2.6 THE PROVISIONAL REJECTION FOR OBVIOUSNESS-TYPE DOUBLE PATENTING IS NOTED.**

***Claims 8-19, 32-35, 39-40, and 46-52 were provisionally rejected for obviousness-type double patenting over commonly-owned co-pending application 09/787,840. (Action at page 3)***

Applicants respectfully traverse. However, they note for the record that the cited application and the present application are commonly owned, and as such, the rejection may be overcome by submission of an executed terminal disclaimer in compliance with 37 C. F. R. § 1.321(b)(c) and (d), disclaiming the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U. S. C. §§ 154 to 156 and 173, as shortened by any terminal disclaimer, of a patent that would grant based upon the co-pending application which is commonly owned with the present application.

Applicants also note for the record, however, that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of

the rejection. *Quad Environmental Technologies Corp. vs. Union Sanitary District*, 20 USPQ 2d 1392 (Fed. Cir. 1991).

The Court in *Quad* indicated that:

"filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

Applicants elect to defer submission of that paper until such time as all claims are allowed in the present case. Applicants therefore request that the Rejection be held in abeyance until a notice of allowability is received.

**2.7 THE REJECTION OF CLAIMS UNDER 35 U. S. C. § 112, 2<sup>ND</sup> PARAGRAPH, IS OVERCOME.**

*Claims 8-19, 32-35, 39-40, and 44-52 were rejected under 35 U. S. C. § 112, 2<sup>nd</sup> paragraph, allegedly as being indefinite. (Action at page 5)*

Applicants respectfully traverse. However, Applicants appreciate the helpful suggestions of the Examiner to further improve the clarity and to more distinctly point out and claim aspects of the present invention. To that end, claims have been amended to address the particular clarity issues raised by the Office.

Claims 8, 32, and 33 were clarified to recite that P is "an amino acid or a linear peptide of 2 to 15 monomers." This addresses the clarity issue with respect to the word monomer. Dependent claims were also clarified as required to ensure proper antecedent basis to the clarified base claims. Applicants request that this rejection be withdrawn.

Claim 12 was clarified to recite that substituents could be "subsequently linked to a solid support or linked to another cyclic peptide or peptidomimetic compound....." This addresses the

clarity issue with respect to the term “derivatised”. Applicants request that this rejection be withdrawn.

Claim 19 was clarified to recite that “A2 is formed by reacting an amino nitrogen in P with a compound of general formula (a).....” This addresses the clarity issue with respect to the functionality of Z which forms a covalent bond with an amino acid nitrogen in the peptide. Applicants request that this rejection be withdrawn.

Claims 46 and 48 were clarified to conform the claimed structure of A2 to the general formula 3 of claim 8, and to the 6-membered ring structure of claim 19. Applicants request that this rejection be withdrawn.

Although claims 32, 39, and 50 were rejected allegedly because it is not clear what cyclic peptide would be produced if A1 is not a reversible substituent. Applicants respectfully explain that if A1 is not a reversible substituent, then the method will result in a cycle peptide in which A1 remains attached to the peptide. In other words, an N-substituted cyclic peptide is produced. Applicants assert that N-substituted peptides would be clearly understood by an artisan skilled in this field having benefit of the teachings of the instant Specification. As such, Applicants request that the rejection of these claims be withdrawn.

Applicants believe this to be a complete response to the rejections under this section of the Statutes, and respectfully request that all rejections be withdrawn.

### **3.0 CONCLUSION**

It is respectfully submitted that all pending claims are fully enabled by the Specification, and that all claims are definite, and free of any concerns of prior art. Applicants believe that the claims are acceptable under all sections of the Statutes and are now in conditions for ready

allowance, and that all of the concerns of the Examiner have been resolved. Applicants further respectfully request, therefore, the withdrawal of all rejections and that a Notice of Allowance be issued in the case with all due speed. However, Applicants also note for the record their explicit right to re-file claims to one or more aspects of the invention as originally claimed in one or more continuing application(s) retaining the priority claim from the present and parent cases.

Should the Examiner have any questions, a telephone call to the undersigned Applicants' new representative would be appreciated.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark D. Moore", written over a horizontal line.

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Date: August 30, 2005

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